

including a sight line. This arrangement is nowhere taught or suggested in the cited reference.

Spiegel does not disclose a cavity in a center section for receiving an insert. Instead, Spiegel discloses an indicator including a fluid filled container that is "fixed atop" a trailing flange of the primary structure of a putter head (see Spiegel, col. 1, lines 59-60).

Spiegel does not disclose a floor of a center section which includes a sight line visible through the rear insert. Spiegel refers to a "center line" (40) positioned on the top of the putter blade forward of the indicator assembly (see Spiegel, Fig. 1), not visible through the fluid container.

The Office Action apparently erroneously equates the sight line of the instant application is equivalent to the "groove" (36) of Spiegel (see page 3 of the Office Action). Applicants respectfully disagree. Spiegel does not describe a "groove" as a sight line, but rather, as a "depression within which a ball element may rest by gravity" (see Spiegel, col. 3, lines 38-39).

Furthermore, according to Spiegel and according to the Office Action's own admission, the "groove" of Spiegel is incorporated into the floor of the insert or container, not into the floor of a cavity for receiving an insert. See Spiegel, col. 3, lines 31-32 ("an elongated groove (36) extends in a base wall or floor portion of a container"); see also page 3 of the Office Action ( "Note the sight line or groove (36) which is incorporated into within the floor portion of the insert" ) (emphasis added). There is in Spiegel no floor of a center section of a club head that includes a sight line.

For at least the foregoing reasons, claims 7 and 29 are not anticipated by Spiegel. Applicants respectfully request reconsideration and withdrawal of this rejection.

2. Claims 1, 3-6, 8-10, and 16-20 were rejected under 35 U.S.C. § 103(a) over Kubica U.S. Pat. 6,206,790 in view of Cochran U.S. Pat. 3,995,857. Claim 1 is independent.

The presently claimed golf club head includes, *inter alia*, a substantially transparent rear-insert and a center section having a floor, and a cavity therein for receiving the rear-insert (see independent claim 1). This arrangement is nowhere taught or suggested in the cited references.

Kubica does not teach or suggest a substantially transparent rear-insert or a center section for receiving an insert. Instead, Kubica teaches an iron element with a primary and a secondary cavity within the primary cavity, and a weight adjustment member located in a secondary cavity (see Kubica, Figs. 1 and 9, and col. 3, lines 7-8).

Cochran fails to provide the deficiencies in Kubica, or vice versa, and there is no motivation in either of the references to combine any teachings of Cochran with any portion of Kubica.

Cochran does not teach or suggest a substantially transparent rear-insert. Instead, Cochran teaches a golf club with a steel head preferably having tungsten weights in the heel and toe sections (see col. 4, lines 29-24). Thus, neither Kubica, nor Cochran, nor their combination teach or suggest the golf club head of Applicants' claim 1. For the foregoing reasons, neither reference contains any disclosure, teaching, suggestion, reason, motivation, or incentive that would have led

one of ordinary skill in the art to the Applicants' claimed invention. Thus, claim 1, and the claims that depend therefrom, are patentable over the cited references.

3. Claim 12 was rejected under 35 U.S.C. § 103 as being unpatentable over Kubica in view of Cochran and McGeeney U.S. Pat. 5,938,543. Claim 12 depends from claim 1.

Applicants' claims have above herein been distinguished from Kubica and Cochran. McGeeney does not provide the deficiencies of Kubica or Cochran explained herein, as applied to claim 1, from which claim 12 depends.

McGeeney does not teach or suggest a substantially transparent rear-insert or a cavity in a center section for receiving the rear insert. McGeeney teaches a golf club head with a "uniform depthwise construction" with three discrete segments in the head-to-toe direction. In addition, McGeeney teaches away from Kubica and Cochran by stating that its design "alleviates...the disadvantages of golf club heads having perimeter weighed elements" (see McGeeney, col. 2, lines 42-43 of). It is improper to combine references where the references teach away from their combination (MPEP § 2145). Thus, neither Kubica, nor Cochran, nor McGeeney, nor any combination thereof teaches or suggests the device of Applicants' claim 1, and the claims that depend therefrom. For the foregoing reasons, none of the cited references contain any disclosure, teaching, suggestion, reason, motivation, or incentive that would have led one of ordinary skill in the art to the Applicants' claimed invention. Accordingly, claim 12 is patentable over the cited references.

4. Claims 14-15 were rejected under 35 U.S.C. § 103 over Kubica in view of Cochran and in view of Buettner U.S. Pat. 5,531,444. Claims 14 and 15 depend from claim 1.

Applicants' claims have been distinguished from Kubica and Cochran above. Buettner fails to provide the deficiencies of Kubica or Cochran as applied to claim 1 and there is no motivation to combine any of these references. Buettner does not teach or suggest a rear insert, let alone a substantially transparent rear-insert or a cavity in a center section for receiving a rear insert. Instead, Buettner teaches an apparatus and method for coating the surface of golf club heads (see Buettner, col. 3, lines 15-21). Thus, none of Kubica, nor Cochran, nor Buettner, nor any combination thereof teaches or suggests the device of Applicants' claim 1. For the foregoing reasons, none of the references contains any disclosure, teaching, suggestion, reason, motivation, or incentive that would have led one of ordinary skill in the art to the Applicants' claimed invention. Accordingly, claims 14-15 are patentable over the cited references.

5. Claims 21-24, 27-28, 30 and 32 were rejected under 35 U.S.C. § 103 over Rudell U.S. Pat. No. 4,390,184. Claims 22, 23, 24, 27, 28, 30 and 32 all depend from claim 21.

The presently claimed golf club head includes, *inter alia*, a substantially transparent rear insert, a center section having a floor and a cavity in a center section for receiving a rear insert, and a face insert coupled to the strike face (see independent claims 1 and 21). Rudell does not teach or suggest a substantially transparent rear insert or a cavity in a center

section for receiving the rear insert. Rudell teaches a golf putter head with a W-shape with a leading surface and three trailing portions(see Rudell, col. 2, lines 5-7).

The Office Action erroneously contends that Rudell teaches a "sole" that is a floor upon which an insert is positioned. Applicants respectfully disagree. Rudell does not teach or suggest a rear insert of any kind, let alone a floor or a cavity in a center section for receiving the rear insert. Rudell teaches a front surface and an optional thin sole plate. Such a separate sole plate is not an integral part of the club head body. The erroneous theory posed in this Office Action would replace the club head body with Applicants' transparent insert -- a modification nowhere suggested by the prior art itself. Further, if the plate covered the entire lower surface, Rudell teaches that it can have the disadvantage of "detrimentally lowering the club head center of gravity, so it is not preferred" (see Rudell, col. 4, lines 40-50). Thus, Rudell teaches away from fastening a sole plate across the entire putter lower surface because doing so would "diminish alignment and stroking advantages" (see Rudell, col. 4, line 49). For at least these reasons, Rudell does not teach or suggest the device of Applicants' claim 21. Accordingly, claim 21 and the claims that depend therefrom are patentable over Rudell.

6. Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rudell in view of Fisher U.S. Pat. 5,674,132. Claim 25 depends from claim 21.

Applicants' claim 21 has above herein been distinguished from Rudell. Fisher fails to remedy the deficiencies of Rudell. Fisher does not teach or suggest a cavity in a center section

for receiving a rear insert. Fisher teaches a golf club head with a resilient insert in the ball-impacting face of the club head. Fisher does not teach or suggest that a rear-insert or a transparent insert would be desirable. Thus, neither Rudell, nor Fisher, nor any combination thereof teaches or suggests the device of Applicants' claim 21. Accordingly, claim 21 and the claims that depend therefrom, including claim 25, are patentable over Rudell in view of Fisher.

7. Claims 1, 6, 10, 13, 16 and 26 were rejected under 35 U.S.C. § 103(a) over Rudell in view of Reiss U.S. Pat. 4,444,395. Claims 6, 10, 13, and 16 depend from claim 1. Claim 26 depends from claim 21.

Applicants have above herein distinguished claims 1 and 21 from Rudell. Reiss fails to remedy the deficiencies of Rudell. Reiss does not teach or suggest a cavity in a center section for receiving a rear insert. Reiss teaches a golf club head having a central section to which the shaft is attached, connected to interchangeable outer sections by interconnecting pins or by adhesive means (see Reiss col. 2, lines 60-65). There is no motivation to include a rear insert in Reiss because it is the outer ends of the club head that are interchangeable to provide the necessary modifications in weight, not the center section. Thus, neither Rudell, nor Reiss, nor any combination thereof teaches or suggests the device of claim 1 or 21, and the claims that depend therefrom. Accordingly, claims 1, 6, 10, 13, 16 and 26 are patentable over the cited references.

8. Claim 31 was rejected under 35 U.S.C. § 103(a) over Rudell in view of Buettner. Claim 31 depends from claim 21.

Applicants have distinguished claim 21 over both Rudell and Buettner. Neither Rudell nor Buettner nor any combination thereof teaches or suggests a rear insert, let alone a substantially transparent rear-insert or a cavity in a center section for receiving a rear insert. For the foregoing reasons, neither reference contains any disclosure, teaching, suggestion, reason, motivation, or incentive that would have led one of ordinary skill in the art to the Applicants' claimed invention. Thus, claim 21, and the claims that depend therefrom are patentable over Rudell in view of Buettner.

9. Claims 21, 23-24, 27-28, and 32-33 were rejected under 35 U.S.C. § 103(a) over Ebbing. Claims 23-24, 27-28, and 32-33 depend from claim 21.

The presently claimed golf club head includes, *inter alia*, a substantially transparent rear insert and a face insert. Ebbing does not teach or suggest a substantially transparent rear insert in addition to a striker insert. Ebbing teaches only a reversible striker insert positioned inside the club head (see Ebbing, Fig. 4 and col 4, lines 63-65). There is no teaching or motivation to include a substantially transparent material for a rear insert that is located inside a cavity. Thus, Ebbing does not teach or suggest the device of Applicants' claim 21.

Furthermore, Applicants also submit that this rejection is based on impermissible hindsight reconstruction of Applicants' claimed invention. See MPEP 2145, paragraph X. A. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests

Applicant : Brian Pond, et al.  
Serial No. : 10/016,179  
Filed : October 30, 2001  
Page : 9 of 10

Attorney's Docket No.: 28952.5564

the desirability of the combination. See MPEP 2143.01, citing In re Mills, 916 F.2d 680 (Fed. Cir. 1990).

Accordingly, claims 21, 23-24, 27-28, 32, and 33 are patentable over Ebbing. Applicants respectfully request reconsideration and withdrawal of this rejection.



CONCLUSION

For all the foregoing reasons, there is no disclosure or teaching in any of the references of record, which discloses or teaches all of the elements of any of the Applicants' claims.

Furthermore, there is no disclosure, teaching, suggestion or motivation in any of those references which suggests the desirability of combining any portions thereof effectively to anticipate or suggest the presently claimed invention.

Accordingly, all claims now pending are patentably distinguished over all grounds of rejection cited in the Office Action. Accordingly, allowance of claims 1, 3-10 and 12-39 is hereby respectfully solicited.


Should the Examiner deem it helpful, he is invited to telephone the applicants' undersigned representative.

Please apply any charges or credits to deposit account 19-4293.

Respectfully submitted,

STEPTOE & JOHNSON LLP

Date: Dec. 30, 2005

  
\_\_\_\_\_  
Roger W. Parkhurst  
Registration No. 25,177

Attorney Docket No.: 28952.5564

STEPTOE & JOHNSON LLP  
1330 Connecticut Avenue, NW  
Washington, DC 20036-1795  
Phone: 202-429-3000  
Fax: 202-429-3902